

ESTTA Tracking number: **ESTTA187599**

Filing date: **01/18/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	New York Yankees Partnership
Granted to Date of previous extension	01/20/2008
Address	Executive Offices Yankee Stadium Bronx, NY 10451 UNITED STATES
Attorney information	Antonio Borrelli Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES axb@cll.com, trademark@cll.com Phone:(212) 790-9200

Applicant Information

Application No	77012141	Publication date	07/24/2007
Opposition Filing Date	01/18/2008	Opposition Period Ends	01/20/2008
Applicant	DiMaggio, LLC 4040 Sheridan St. Hollywood, FL 33021 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. First Use: 1994/01/01 First Use In Commerce: 1994/01/01 All goods and services in the class are opposed, namely: Paper articles; namely, paper bags, posters, postcards, calendars, greeting cards, trading cards, art prints, lithographic prints, note books, picture books, photographic prints, portraits, art cards; magazines featuring sports, travel, restaurants
Class 025. First Use: 1994/01/01 First Use In Commerce: 1994/01/01 All goods and services in the class are opposed, namely: Clothing; namely, shirts, T-shirts, tank tops, jerseys, sweatshirts, sweaters, shorts, sweatpants, bicycle pants, bicycle skinsuits, leotards, sleepwear, beachwear, jackets, belts, rainwear, socks, aprons, cloth bibs, kerchiefs, and wrist bands; headwear; namely, hats, caps visors, and head bands; neckwear; namely, scarves, bandanas, and neckties; autographed sports memorabilia, namely, hats and jerseys
Class 028. First Use: 1994/01/01 First Use In Commerce: 1994/01/01 All goods and services in the class are opposed, namely: Toys and games; namely, action or play figurines, plastic animal replica figurines, water squirting toys; autographed sports memorabilia, namely baseballs; toy sports figurines, trading card games, bendable toys, rubber character toys, plastic character toys, inflatable toys, squeeze toys, dolls and sports balls, card games, board games, toy figures and stuffed toys, mechanical action and mobile toys, baby rattles, kites, jigsaw puzzles, board games, party favors in the nature of small toys, costume masks, and plush animals; dolls;

holiday items; namely, Christmas tree ornaments and decorations; and protective head covers for golf clubs
Class 035. First Use: 1994/01/01 First Use In Commerce: 1994/01/01 All goods and services in the class are opposed, namely: Retail store services featuring sports, outdoor and travel equipment, clothing, footwear, sports, outdoor and travel accessories and publications; mail order retail services featuring sports, outdoor and travel equipment, clothing, footwear, sports, outdoor and travel accessories and publications; on-line retail store services featuring sports, outdoor and travel equipment, clothing, footwear, sports, outdoor and travel accessories and publications; Commercial administration of the licensing of rights to sports photos, trademark, and audiovisual programs of others
Class 043. All goods and services in the class are opposed, namely: Restaurant services

Grounds for Opposition

Other	Please see attached pleading.
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Attachments	yankeelet.pdf (2 pages)(87642 bytes) yankeenoo.pdf (7 pages)(34832 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Antonio Borrelli/
Name	Antonio Borrelli
Date	01/18/2008

Cowan, Liebowitz & Latman, P.C.

Law Offices

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Antonio Borrelli

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January 18, 2008

By Electronic Filing

Commissioner for Trademarks

P.O Box 1451

Alexandria, VA 22313-1451

Attention: Trademark Trial and Appeal Board

Re: New York Yankees Partnership
Notice of Opposition Against
DiMaggio, LLC's
Application to Register YANKEE CLIPPER
Attorney Ref. No. 21307.033

Dear Commissioner:

We enclose a Notice of Opposition against Application Serial Number 77/012,141, published in the Official Gazette of July 24, 2007. Contemporaneously with the electronic filing of this Notice of Opposition, we are arranging for an electronic payment in the amount of \$1,500 to cover the filing fee.

If the amount received is insufficient and additional fees are required, please charge our Deposit Account No. 03-3415.

Cowan, Liebowitz & Latman, P.C.

Commissioner for Trademarks

January 18, 2008

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Please address all future correspondence to the attention of Mary L. Kevlin, Esq. of
Cowan, Liebowitz & Latman, P.C.

Respectfully submitted,

/Antonio Borrelli/

Antonio Borrelli

Enclosure

cc: Ms. Diane Kovach (w/enc. – by fax)
Mary L. Kevlin, Esq. (w/enc.)
Richard S. Mandel, Esq. (w/enc.)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 77/012,141
Filed: October 2, 2006
For Mark: YANKEE CLIPPER
Published in the Official Gazette: July 24, 2007

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NEW YORK YANKEES PARTNERSHIP,	:	
	:	
Opposer,	:	
	:	
v.	:	<u>NOTICE OF OPPOSITION</u>
	:	
DIMAGGIO, LLC,	:	
	:	
Applicant.	:	Opposition No.
-----X	:	

Commissioner for Trademarks
ATTN: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Opposer, New York Yankees Partnership, an Ohio limited partnership, located at Executive Offices, Yankee Stadium, Bronx, NY 10451, believes that it will be damaged by registration of the word mark YANKEE CLIPPER for goods and services in International Classes 16, 25, 28, 35 and 43 as shown in Application Serial No. 77/012,141 (the "Application"), and having been granted extensions of time to oppose up to and including January 20, 2008, hereby opposes the same.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of the renowned NEW YORK YANKEES MAJOR LEAGUE BASEBALL club.

2. Since long prior to January 1, 1994, Applicant's claimed first use date for its Class 16, 25, 28 and 35 goods and services, Opposer, its predecessors, their affiliated and related entities, licensees and/or sponsors have used the names and marks YANKEE or YANKEES, alone and/or with other word, letter or design elements (collectively, "Opposer's YANKEES Marks"), in connection with baseball game and exhibition services and a wide variety of goods and services, including, without limitation, clothing, paper goods and printed matter, toys, sporting goods, novelties, and retail store services, and the media, press, and public have used the name and mark YANKEE to refer to and identify players of Opposer's baseball club. Since long prior to October 2, 2006, Applicant's constructive first use date for its Class 43 services, Opposer, its predecessors, their affiliated and related entities, licensees and/or sponsors have used Opposer's YANKEES Marks in connection with food and beverage products and services including restaurant services.

3. Opposer owns U.S. Federal registrations and applications for Opposer's YANKEES Marks in International Classes 6, 9, 14, 16, 18, 20, 21, 24, 25, 26, 28, 30, 34 and 41, namely, Registration Nos. 3,345,306, 3,320,068, 3,320,069, 3,320,070, 3,331,059, 3,326,223, 3,326,224, 3,326,225, 3,191,653, 3,022,847, 2,994,114, 3,022,848, 2,970,918, 2,575,644, 2,940,306, 2,867,047, 2,867,048, 2,843,353, 2,858,237, 2,632,493, 2,309,488, 2,889,384, 2,866,959, 2,886,760, 2,368,952, 1,671,731, 1,542,501, 1,550,798, 1,161,865, 1,073,346 and 1,032,767 and Application Serial Nos. 78/843,337, 77/009,819 and 78/843,342. Registration Nos. 1,671,731, 1,542,501, 1,550,798, 1,161,865, 1,073,346, 1,032,767, 2,368,952 and 2,309,488 are incontestable.

4. Since long prior to January 1, 1994, Applicant's claimed first use date for its Class 16, 25, 28 and 35 goods and services, Opposer, its predecessors, their affiliated and related

entities, licensees and/or sponsors have promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer's YANKEES Marks, including, but not limited to, baseball game and exhibition services and a wide variety of goods and services, including, without limitation, clothing, paper goods and printed matter, toys, sporting goods, novelties, retail store services, and have sold or distributed such goods and rendered such services in commerce. Since long prior to October 2, 2006, Applicant's constructive first use date for its Class 43 services, Opposer, its predecessors, their affiliated and related entities, licensees and/or sponsors have promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer's YANKEES Marks including, but not limited to, in connection with food and beverage products and services including restaurant services, and have sold or distributed such goods and rendered such services in commerce.

5. As a result of the extensive sales and promotion of its goods and services bearing or offered in connection with Opposer's YANKEES Marks, Opposer has built up highly valuable goodwill in Opposer's YANKEES Marks, and said goodwill has become closely and uniquely identified and associated with Opposer.

6. On October 2, 2006, Applicant filed the Application to register the word mark YANKEE CLIPPER for "Paper articles; namely, paper bags, posters, postcards, calendars, greeting cards, trading cards, art prints, lithographic prints, note books, picture books, photographic prints, portraits, art cards; magazines featuring sports, travel, restaurants" in International Class 16, "Clothing; namely, shirts, T-shirts, tank tops, jerseys, sweatshirts, sweaters, shorts, sweatpants, bicycle pants, bicycle skinsuits, leotards, sleepwear, beachwear, jackets, belts, rainwear, socks, aprons, cloth bibs, kerchiefs, and wrist bands; headwear; namely,

hats, caps visors, and head bands; neckwear; namely, scarves, bandanas, and neckties; autographed sports memorabilia, namely, hats and jerseys” in International Class 25, “Toys and games; namely, action or play figurines, plastic animal replica figurines, water squirting toys; autographed sports memorabilia, namely baseballs; toy sports figurines, trading card games, bendable toys, rubber character toys, plastic character toys, inflatable toys, squeeze toys, dolls and sports balls, card games, board games, toy figures and stuffed toys, mechanical action and mobile toys, baby rattles, kites, jigsaw puzzles, board games, party favors in the nature of small toys, costume masks, and plush animals; dolls; holiday items; namely, Christmas tree ornaments and decorations; and protective head covers for golf clubs” in International Class 28 and “Retail store services featuring sports, outdoor and travel equipment, clothing, footwear, sports, outdoor and travel accessories and publications; mail order retail services featuring sports, outdoor and travel equipment, clothing, footwear, sports, outdoor and travel accessories and publications; on-line retail store services featuring sports, outdoor and travel equipment, clothing, footwear, sports, outdoor and travel accessories and publications; commercial administration of the licensing of rights to sports photos, trademark, and audiovisual programs of others” in International Class 35 based on use in commerce with an alleged first use date of January 1, 1994, and for “Restaurant services” in International Class 43 based on intent to use.

7. Upon information and belief, Applicant did not use the mark YANKEE CLIPPER for the goods and services in Classes 16, 25, 28 or 35 prior to January 1, 1994, Applicant’s claimed first use date, and did not use the mark YANKEE CLIPPER for the services in Class 43 prior to October 2, 2006, Applicant’s constructive first use date.

8. The goods and services covered by the Application are identical and/or closely related to the goods offered and services rendered in connection with Opposer's YANKEES Marks.

9. Upon information and belief, the mark YANKEE CLIPPER is a direct reference to and creates an association with Opposer's famous baseball club and its related goods and services, and, upon information and belief, the goods and services for which Applicant seeks to register the YANKEE CLIPPER mark are offered for sale and/or sold to the same classes of consumers as the goods and services designated by Applicant's YANKEES Marks, and may be advertised and promoted through similar media.

10. Applicant's YANKEE CLIPPER mark so resembles Opposer's YANKEES Marks so as to be likely, when applied to Applicant's goods or services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's goods or services have their origin with Opposer and/or that such goods or services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for the YANKEE CLIPPER mark.

11. Opposer would be further injured by the granting of a certificate of registration to Applicant because the YANKEE CLIPPER mark would falsely suggest a connection between Applicant and Opposer.

WHEREFORE, Opposer believes that it will be damaged by registration of the mark YANKEE CLIPPER and requests that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Mary L. Kevlin, Richard S. Mandel and Antonio Borrelli (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Mary L. Kevlin, Esq. at the address listed below.

Dated: New York, New York
January 18, 2008

Respectfully submitted,
COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Antonio Borrelli/
Mary L. Kevlin
Richard S. Mandel
Antonio Borrelli
1133 Avenue of the Americas
New York, New York 10036
(212) 790-9200

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the foregoing Notice of Opposition to be sent via first class, postage paid mail to Applicant's counsel, Pollie Gautsch, Esq., De Novo Legal, LLP, 171 Saxony Rd., Suite 209, Encinitas, CA 92024-6777, on January 18, 2008.

/Antonio Borrelli/
Antonio Borrelli